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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/013,541 01/26/98 LINNARTZ

J PHN16210

EXAMINER

LM01/1126

U S PHILIPS CORPORATION  
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TARRYTOWN NY 10591

MEISLAHN, D

ART UNIT

PAPER NUMBER

2767

DATE MAILED:

11/26/99

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/013,541

Applicant(s)

Linnartz

Examiner  
Douglas Meislahn

Group Art Unit  
2767



☒ Responsive to communication(s) filed on Aug 6, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-17 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-17 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Jan 26, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. All of the documents listed in the IDS received 27 April 1998 are repeated in the IDS received 8 September 1999, making the former moot. The latter cites two documents, AE and AF, which are neither present nor explained.
2. Line 27 of the first page of the specification cites EP-0545472 as being D1 on a list of relevant documents. Neither the list nor EP-0545472 is currently with the file. The examiner will add the patent to the 892.

### ***Drawings***

3. The drawings are objected to because the figures need labels. Correction is required.
4. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

### ***Specification***

5. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
6. Please add section titles to the specification.

### ***Claim Objections***

7. Claims 5 and 9 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

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Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. All of the limitations of the recorder in claim five, which depends from claim 1, are already in claim 1. All of the limitations of the information carrier of claim 9, which depends from claim 1, are already in the first claim.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1, 4, 5, 9-11, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhalu et al. (5412718) in view of Cox et al. (5930369).

In their abstract, Narasimhalu et al. teach a method of identifying marks on a recording medium and using these marks, which are unique to the medium, to form digital signature which in turn encrypts data. A digital representation of the marks on the recording medium, which would correspond to the present invention's first bitpattern, is necessary in order to form the digital signature, which corresponds to the second bitpattern. Narasimhalu et al. do not say that the digital signature is used as a watermark. Cox et al. teach that watermarks are useful in tracking distribution and representation in lines 24-27 of column 1. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use the digital

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signature of Narasimhalu et al. not only as an encryption key but also as a watermark in order to gain the tracking advantages taught by Cox et al. Cox et al. teach many forms of data in the third paragraph of the first column, video being one of them. Video requires a player and recorder. Furthermore, watermarks gain their use by being used, and therefore Cox et al. renders relationship verification obvious.

In lines 16-17 of their second column, Cox et al. say that an effective watermark unambiguously identifies the owner. This renders obvious applicant's fourth claim and the ones similar to it.

The data written to the information carrier of claim 9 and its dependent claims has no patentable weight because it is merely data that does not cause a computer to function in a specific manner. If written in independent form, claim 9 would probably be non-statutory.

10. Claims 2-3, 12-14, and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhalu et al. in view of Cox et al. as applied to claim 1 above, and further in view of Schneier (*Applied Cryptography*).

Narasimhalu et al. and Cox et al. show a method of using characteristics of a medium in order to create a watermark for the data stored on the medium. They do not say that the characteristics and the watermark are related by a one-way hash function. On page 459, Schneier shows a one-way hash of a message and a key. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention

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was made to create the watermark by using a one-way hash function on the representation of the medium's characteristics, as taught by Schneier.

11. Claims 6-8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Narasimhalu et al. in view of Cox et al. and Schneier as applied to claim 5 above.

Narasimhalu et al. in view of Cox et al. and Schneier teach a method of using characteristics of a medium and a one-way hash function in order to create a watermark for the data stored on the medium. Schneier clearly shows the hash as containing two parts: a key and the message. The key corresponds to the seed of applicant's claims. Narasimhalu et al. say in their abstract that the watermark can be made of any nonuniformities or uniformities at any level. This includes the level of machine-made marks. There is no mention of marking the medium and using that as the characteristic. Official notice is taken that it is old and well-known to mark data mediums in order to instill them with useful information. Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to use a machine-made mark as the basis for the watermark so that the watermark would relate to information pertinent to the data storage medium.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Noguchi et al. (EP 0 581227 A2) and Fayling (4743490).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas J Meislahn whose telephone number is (703)

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305-1338. The examiner can normally be reached on 9AM - 6PM, every other Friday off.

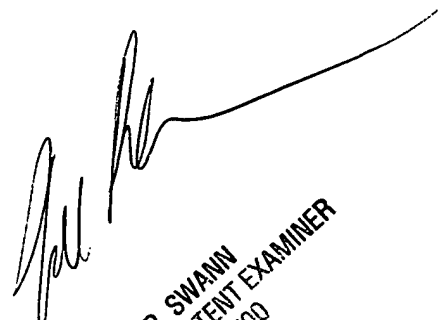
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tod Swann can be reached on (703) 308-7791. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-9051 for regular communications and (703) 308-9052 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Douglas J Meislahn  
Examiner  
Art Unit 2767



DMJ  
November 18, 1999



TOD R. SWANN  
SUPERVISORY PATENT EXAMINER  
GROUP 2700